

REMARKS

I. General

Claims 1-25 are pending in the present application. The issues outstanding with respect to the present Office Action are as follows:

- Claims 1-10 and 12-13 have been rejected under 35 U.S.C. §102(b) as anticipated by JP 01181654 A to Kazunobu et al. (hereinafter “*Kazunobu*”).
- Claims 11 and 16-25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kazunobu*.
- Claims 14 and 15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kazunobu* in view of Silverberg et al., U.S. patent number 4,634,112. (hereinafter “*Silverberg*”).

Applicant respectfully traverses the outstanding rejections and requests reconsideration and withdrawal thereof in light of the remarks contained herein.

II. Issues Under 35 U.S.C. § 102(b)

Claims 1-10 and 12-13 stand rejected under 35 U.S.C. §102(b) as anticipated over *Kazunobu*. To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. The applied reference does not teach every element of the claims. Accordingly, Applicant respectfully traverses this rejection.

Claim 1 recites “a registration tab disposed to deflect an edge of said media when the media passes over the registration tab.” On page 2 of the Action, the Examiner alleges that *Kazunobu* teaches “a registration tab, 13, [comprising] a sloped surface, 13a, presented to [an] edge of media when the media moves by the registration tab toward the registration guide.” Applicant asserts that this is a wholly inaccurate statement. The pressure plate disclosed in *Kazunobu* only functions as a sheet pressing means which opens and closes the gap between a white sheet and a butting plate. To prevent a reversely transported original 200 from through feeding over butting plate 101, “sheet 9 is pressed to . . . butting plate 101 by . . . pressure plate 13, and these two [sheet and butting plate] are closed together,” see English Abstract and Figures 1, 2a, 2b and 4. Pressure plate 13 is at all times separated from

original 200 by white sheet 9, see Figures 2a and 2b. Pressure plate 13 does not present sloped surface 13a to an edge of original 200, and therefore, said edge of original 200 does not pass over the pressure plate. Because all the claim limitations are not met by *Kazunobu*, Applicant respectfully requests withdrawal of the rejection.

Claims 2-10 and 12-13 depend from claim 1. Accordingly, each of these dependent claims is asserted to be patentable over the 35 U.S.C. § 102 rejections of record at least for the reasons set forth above with respect to claim 1.

III. Issues Under 35 U.S.C. § 103(a)

A. The 35 U.S.C. § 103 Rejections Based Upon *Kazunobu*

Claims 11 and 16-25 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Kazunobu*. To render a claim unpatentable under 35 U.S.C. § 103, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. § 2143.03. Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, see MPEP 2143.01. Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious, see MPEP § 2143.03. The 35 U.S.C. § 103 rejections on record do not meet the foregoing criteria. Accordingly, Applicant respectfully traverses this rejection.

1. Claim 11

As discussed above, *Kazunobu* does not meet the claim limitations of claim 1. Claim 11 is dependent on claim 1 and includes all of the limitations of claim 1. Because these claim limitations are not met by *Kazunobu*, the 35 U.S.C. § 103 rejection of claim 11 fails. Applicant respectfully requests withdrawal of the rejection.

2. Claims 16-20

The Examiner acknowledges that *Kazunobu* does not explicitly teach a method for de-skewing media using an automatic feeder on page 4 of the Action. However, the Examiner

asserts that the apparatus disclosed in *Kazunobu* “would obviously perform the method steps of claims 16-18 and 20.”

Specifically, the Examiner alleges the apparatus disclosed in *Kazunobu* would perform the step of “translating media in a first direction to pass a first edge by said registration tab.” As discussed above, the pressure plate disclosed in *Kazunobu* only functions as a sheet pressing means which opens and closes the gap between a white sheet and a butting plate. To prevent a reversely transported original 200 from through feeding over butting plate 101, “sheet 9 is pressed to . . . butting plate 101 by . . . pressure plate 13, and these two [sheet and butting plate] are closed together,” see English Abstract and Figures 1, 2a, 2b and 4. Pressure plate 13 is at all times separated from original 200 by white sheet 9, see Figures 2a and 2b. Pressure plate 13 does not present sloped surface 13a to a first edge of original 200, and therefore, said first edge of original 200 does not pass by the pressure plate.

The Examiner also alleges that the apparatus disclosed in *Kazunobu* would perform the step of “deflecting with said registration tab said first edge” As discussed above, the pressure plate disclosed in *Kazunobu* only functions as a sheet pressing means which opens and closes the gap between a white sheet and a butting plate. To prevent a reversely transported original 200 from through feeding over butting plate 101, “sheet 9 is pressed to . . . butting plate 101 by . . . pressure plate 13, and these two [sheet and butting plate] are closed together,” see English Abstract and Figures 1, 2a, 2b and 4. Pressure plate 13 is at all times separated from original 200 by white sheet 9 and does not present sloped surface 13a to a first edge of original 200, see Figures 2a and 2b. Therefore, pressure plate 13 does not deflect said first edge.

Still further, the Examiner alleges the apparatus disclosed in *Kazunobu* would perform the step of “continuing to apply a translation force to said media after at least a portion of said first edge engages said registration guide.” Nowhere in the abstract of the cited reference is this taught or suggested. Therefore, the Examiner’s assertion must be based solely on the assessment of the figures in the *Kazunobu* patent. Applicant disagrees that such a conclusion can be made from any of the figures. Absent some basis for determining that the apparatus disclosed in *Kazunobu* would perform the step at hand, Applicant asserts that this limitation is also not met by the cited reference.

Applicant respectfully asserts that the cited reference does not contain all the claim limitations. Because the above referenced limitations are not taught by *Kazunobu*, the Examiner's rejection under 35 U.S.C. §103(a) fails. Applicant respectfully requests withdrawal of the rejection.

Claims 17-20 depend from claim 16. Accordingly, each of these dependent claims is asserted to be patentable over the 35 U.S.C. § 103 rejections of record at least for the reasons set forth above with respect to claim 16.

3. Claims 21-25

Claim 21 recites "a media translation mechanism disposed to . . . cause an edge of the media to engage said registration tab, wherein engaging said registration tab by said edge causes said edge to deflect towards a registration guide." As discussed above, the pressure plate disclosed in *Kazunobu* only functions as a sheet pressing means which opens and closes the gap between a white sheet and a butting plate. To prevent a reversely transported original 200 from through feeding over butting plate 101, "sheet 9 is pressed to . . . butting plate 101 by . . . pressure plate 13, and these two [sheet and butting plate] are closed together," see English Abstract and Figures 1, 2a, 2b and 4. Pressure plate 13 is at all times separated from original 200 by white sheet 9 and does not present sloped surface 13a to an edge of original 200, see Figures 2a and 2b. Therefore, said edge of original 200 does not engage the pressure plate and is not deflected towards the registration guide by engaging the pressure plate. Hence, *Kazunobu* does not teach or suggest all the claim limitations in claim 21.

The Examiner acknowledges that *Kazunobu* teaches media comprising sheet media and does not specifically teach media comprising photographic media on page 5 of the Action. However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention "to use photographic media with the de-skewing system taught by [*Kazunobu*] if one desired to be able to photocopy and scan photographs." Applicant respectfully disagrees. As can be seen in Figure 1, the system taught by *Kazunobu* comprises a singulator and take-up mechanism having a "C-shaped" feed path. As discussed in [0002] of the specification, such "C-shaped" feed paths work adequately with respect to typical paper stock, but are typically unacceptable for use with other media, such as photographic media. For example, the thick rigid nature of the photographic media results in

jams and misfeeds. Accordingly, one of ordinary skill in the art would not have been motivated to make the proffered combination.

Moreover, it is well established that the prior art must suggest the desirability of the claimed invention, M.P.E.P. § 2143.01. As can be seen from the abstract and figures, *Kazunobu* does not set forth such desirability. On page 5 of the Action, the Examiner states it would have been obvious to one of ordinary skill in the art at the time of the invention “to use photographic media with the de-skewing system taught by [*Kazunobu*] if one desired to be able to photocopy and scan photographs.” The Examiner does not provide a reason for the combination except to achieve the results of the combination. The Examiner provides a mere statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, see M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Because not all the claim limitations are taught by *Kazunobu* and there is no teaching, suggestion or motivation to make the modification, the Examiner’s rejection under 35 U.S.C. §103(a) fails. Applicant respectfully requests withdrawal of the rejection.

Claims 17-20 depend from claim 16. Accordingly, each of these dependent claims is asserted to be patentable over the 35 U.S.C. § 103 rejections of record at least for the reasons set forth above with respect to claim 16. As discussed above, claim 21 is unobvious in view of JP ‘654. Because claims 22-25 are dependent on claim 21, JP ‘654 does not render claims 22-25 obvious. Applicant respectfully requests withdrawal of the rejections.

B. The 35 U.S.C. §103 Rejections Based Upon *Kazunobu* in view of *Silverberg*

Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Kazunobu* in view of *Silverberg*. To render a claim unpatentable under 35 U.S.C. § 103, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. § 2143.03. Additionally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious, see MPEP § 2143.03. The 35 U.S.C. § 103 rejections on

record does not meet the foregoing criteria. Accordingly, Applicant respectfully traverses this rejection.

As discussed above, claim 1 is not anticipated by *Kazunobu* and is, therefore, unobvious in view of *Kazunobu*. Because claims 14 and 15 are dependent on claim 1, *Kazunobu* does not render claims 14 and 15 obvious. Applicant does not believe the limitations absent from *Kazunobu* are found in *Silverberg* and the Examiner has not shown otherwise. Therefore, *Kazunobu* in view of *Silverberg* does not render claims 14 and 15 obvious. Applicant respectfully requests withdrawal of the rejection.

IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 200308992-1 from which the undersigned is authorized to draw.

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Date: May 10, 2006